

### **Remarks/Arguments**

Applicant acknowledges that claims 13, 14 and 18-21 are allowed.

The Examiner suggested that the foreign priority application needs to be cross-referenced in the specification or by filing an ADS. Applicant traverses this suggestion. This application is a national phase entry of PCT/CA2003/001218. It is not a continuation application claiming priority from PCT/CA2003/001218. In consequence it is submitted that there is no requirement to cross-reference PCT/CA2003/001218. Applicant further submits that there is no requirement to cross-reference Canadian patent application no. 2,397,576 from which priority is claimed in PCT/CA2003/001218 since 35USC 119(e) and 120, which are the subject of MPEP 201.11 referenced by the Examiner, deal only with domestic priority claims.

The Examiner rejected claim 5, 11, and 12 under 35 USC 112 and indicated that this objection would be avoided if claim 5 were amended to indicate that the image were a fingerprint image and claims 11 and 12 were cancelled. In response, claim 5 has been so amended and claims 11 and 12 cancelled.

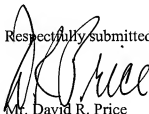
The Examiner rejected claims 1, 4-12, 16 and 17 under 35 USC 101 as not falling within one of the four statutory categories of invention and referenced *In Re Bilski* in this regard. These claims are directed to a method. *Bilski* states that a claimed process should be considered as statutory subject matter "if: (1) it is tied to a particular machine or apparatus or (2) it transforms a particular article into a different state or thing."

Claims 11 and 12 have been cancelled. Claims 4 to 10, 16 and 17 depend directly or indirectly from claim 1 and Applicant therefore submits that these claims should be considered to relate to statutory subject matter if claim 1 is properly considered to relate to statutory subject

matter. In claim 1, a fingerprint image is transformed into a compact representation of the fingerprint image. Applicant submits that this meets the second prong of the *Bilski* test. In other words, the method of claim 1 transforms a fingerprint image into a different state or thing. Applicant therefore traverses this objection of the Examiner.

In view of the foregoing, early favourable consideration of this application is earnestly solicited.

Respectfully submitted,



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